

**REMARKS**

Entry of these amendments and reconsideration of the rejections in view of the foregoing amendment and the following remarks is respectfully requested.

By the foregoing amendment, claims 22, 31, and 44 have been amended. Thus, claims 22-47 are currently pending.

In the Office Action mailed August 17, 1999, the Examiner objected to specific phraseology in the preambles of claims 22 and 31. The preamble language cited by the Examiner could not be identified in claim 22. Preamble language identified by the Examiner was identified in claims 31 and 44. To clarify these claims, selected preamble language was moved from the preamble for each of claims 22, 31, and 44. The Examiner is requested to contact the undersigned representative if additional clarification is needed.

The Examiner rejected claims 31-32 and 44-47 under § 102(e) as anticipated by, or, in the alternative, § 103(a) as obvious over U.S. Patent No. 5,586,766 to Forte et al. in view of the Ten Stix 21 game. To the extent that these rejections might still be applied to the claims currently pending, they are respectfully traversed as follows.

It is respectfully submitted that claims 31 and 44, as amended, are patentable over the prior art of record at least for the following reasons. It is respectfully submitted that Forte et al. does not disclose or suggest an "option to select . . . to receive a bonus point upon the occurrence of a bonus event" as asserted by the Examiner. Instead, Forte et al. provides for play of the game, including the auxiliary game, potentially by use of an ante, and the simple recordation of a jackpot tally event upon its occurrence, as provided by players' notice to the

dealer of such occurrence. Forte et al. does not disclose providing players an option to select to advance at least one tier upon occurrence of the bonus event, as claimed in claims 31 and 44.

Further, it is respectfully submitted that Forte et al. fails to disclose or suggest features providing an incentive to play for players as claimed by the present invention. Forte et al. provides a player counter system for tracking the number of player jackpot tally and dealer counter events occurring during a card game. The disclosed jackpot tally events occurring are such events as consecutive natural or blackjack hands by the players or other winning hands consecutively occurring (see, e.g., col. 3, lines 47-49; col. 4, lines 4-19) or other lower probability player events such as a twenty-one hand count, or relatively low probability dealer events such as consecutive dealer busts or naturals, and are disclosed only for winning events for players. In contrast, claims 31 and 44, as amended, provide an incentive for players to play regardless of whether the players are winning or losing the card game by providing a random event that regularly occurs without the need for combinations of events or other low probability events.

It is also respectfully submitted that the present invention is patentable over Forte et al. in view of the Ten Stix 21 game at least for the following reasons. Claims 31 and 44 provide for a controller to control the display of bonus points. This feature is important not primarily for the reason of "easing the record keeping responsibilities of the dealer" as alleged by the Examiner, but to prevent improper play by the players, a problem identified by the Ten Stix 21 game (see, e.g., specification at p. 4, lines 23-30) and solved by tracking the

player counts using electronic displays, rather than the lammers of the prior art, in conjunction with a controller for controlling the display. Neither Forte et al. nor the Ten Stix 21 game disclose or suggest such a protective feature as claimed. To further clarify this feature's importance, claim 44 has been amended to incorporate specific reference to the advantage of preventing unauthorized transfer of bonus points among players.

It is therefore respectfully submitted that claims 31 and 44 are allowable over the prior art of record. It is further respectfully submitted that claims 32 and 45-47, which depend from allowable claims 31 and 44, are likewise allowable.

The Examiner also rejected claims 22-30 and 33-43 under § 103(a) as unpatentable over Forte et al. in view of U.S. Patent No. 5,788,573 to Baerlocher et al., and apparently in view of U.S. Patent No. 5,707,285 to Place et al. and the existing Ten Stix 21 game. To the extent that this rejection might still be applied to the claims currently pending, it is respectfully traversed as follows.

The Examiner admits that Forte et al. does not include several specific features in claims 22, 24-28, 30, and 33-40. The Examiner argues that Baerlocher et al. and Place et al. disclose apparatus for randomizing prizes relating to "generating a random prize" of claim 22, "selecting . . . prizes" of claim 27, "associated probability of selection" of claims 28 and 40, "receiving a dealer input . . . prize" of claim 30, "player control element, . . . players" of claim 37, selected from . . . predetermined prizes" of claim 38, "randomizer . . . prizes" of claim 39 included to increase player enjoyment. The Examiner then states that it would have

been obvious to combine Baerlocher et al. and Place et al. with Forte et al. to render claims 22, 27-28, 30, and 37-40 obvious.

Alternatively, with regard to claims 30 and 37-38, the Examiner argues that providing the player input and dealer input features of these claims are well known in the art and that it would be obvious to add these features to Forte et al. in view of Baerlocher et al. or Place et al., rendering these claims obvious.

The Examiner further alternatively asserts that the features of claims 24-26 and 33-36 would be obvious in light of the Ten Stix 21 game when combined with the automated tracking and display of auxiliary events as taught by Forte et al. or Forte et al. in view of either Baerlocher et al. or Place et al. allegedly in order to ease the record keeping responsibilities of the dealer.

The Examiner did not specifically address claim 23, relating to the game including dealing a plurality of cards and the at least one bonus event including dealing a preselected card; claim 29, relating to generating a random prize upon receipt of an input from a player prior to the generating; or claims 41-43, relating to probability of selection of prizes, a dealer interface unit coupled to the controller, and a display for the dealer interface unit, respectively.

It is respectfully submitted that claim 22, as amended, is allowable over the prior art of record at least for the following reasons. The Examiner admits that Forte et al. does not include the feature of “generating a random prize.” It is respectfully submitted that Forte et al. does not disclose or suggest an option to select to receive a bonus point upon occurrence

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of the bonus event, as claimed in claim 22, as amended. Instead, Forte et al. provides for play of a game, including an auxiliary game, potentially by use of an ante, and the simple recordation of a jackpot tally event upon its occurrence, as provided by players' notice to the dealer of such occurrence. Forte et al. also does not disclose providing players an option to select to advance at least one tier, as claimed in claim 22, as amended.

Further, it is respectfully submitted that none of Forte et al., Baerlocher et al., or Place et al., nor any combination thereof disclose or suggest features for providing an incentive for players to play, as claimed. Forte et al. provides a player counter system for tracking the number of player jackpot tally and dealer counter events occurring during a card game. The disclosed jackpot tally events occurring are such events as consecutive natural or blackjack hands by the players or other winning hands consecutively occurring (see, e.g., col. 3, lines 47-49; col. 4, lines 4-19) or other lower probability player events such as a non-blackjack twenty-one hand count, or relatively low probability dealer events such as consecutive dealer busts or naturals, which are disclosed only for winning events for players. In contrast, the presently claimed invention provides an incentive for players to play regardless of whether the players are winning or losing by providing a random event that regularly occurs without the need for combinations of events or other low probability events. It is therefore respectfully submitted that claim 22 is allowable over the prior art of record.

It is respectfully submitted that claim 23 is allowable over the prior art of record at least because none of Forte et al., Baerlocher et al., or Place et al., nor any combination thereof disclose or suggest features for the play of a card game and auxiliary game as claimed

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in claim 22 in conjunction with use of a preselected card as a bonus event. As claim 22 is allowable and as the additional features of claim 23 are also allowable, it is respectfully submitted that claim 23 is allowable.

Further, as claims 24 and 25 depend from allowable claim 23, and as claims 26-30 depend from allowable claim 22, it is respectfully submitted that claims 24-30 are likewise allowable.

Claims 33-43 depend from claim 31. As claim 31 is allowable over the prior art of record, it is respectfully submitted that claims 33-43 are likewise allowable. Further, these claims are also allowable at least for the additional reasons that none of the prior art of record discloses or suggests a device for play of a card game combined with the auxiliary game as claimed in claim 31, which includes player interface units and a controller for controlling the display of bonus points for each player. As previously discussed, as claimed, the present invention includes player inputs and a controller for assuring proper play by the players in order to overcome the problems of the prior art, not simply for easing record keeping responsibilities of the dealer, as the Examiner has alleged.

With respect to claims 41 and 42, it is further submitted that neither the features of a dealer interface unit coupled to a controller nor a dealer interface unit including a display, as claimed, are taught or suggested by the prior art of record. As the Examiner has not cited any basis for the rejection of these claims, it is respectfully submitted that these claims are allowable.

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It is also respectfully submitted that claims 45-47, which depend from allowable claim 41, are likewise allowable.

The Examiner's Response to Arguments is both unclear and unresponsive to the amendments filed on May 7 and May 21, 1999. In particular, as claimed, the present invention includes an option selection in which, during play in accordance with the invention, a preselected card is playable either in the card game or tradable for play in the auxiliary game, which are not the same as nor obvious in light of paying an ante or wager, as alleged by the Examiner. Claims 33-36, for example, further clearly detail aspects of the option selection that cannot be confused with simply paying an ante or wager. The Examiner has neither provided references nor proper motivations for combining references to render the specific limitations of these claims obvious.

Further, while admitting that Forte et al. does not include "providing . . . option to play . . . tier" of claims 24 and 33, "providing an option . . . game" of claims 25 and 34, "occurs at least once . . . cards" of claim 26, "at least one preventive event, . . . game" of claim 35, and "bust event, . . . event" of claim 36, the Examiner then fails to provide any reference or suggestions of the teaching for each of these limitations. It is respectfully submitted that at least because the Examiner has failed to make even a prima facie showing of obviousness with regard to these features, each of these claims is patentable over Forte et al.

With regard to the Examiner's alternative argument that the Ten Stix 21 auxiliary game and the automated counting features of Forte et al. are obviously combinable for the

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purpose of increasing player enjoyment, it is respectfully submitted that this argument fails at least because such combination does not address the problems of providing a card game with the disclosed auxiliary game and preventing improper play by players that occurs with use of such methods as distribution of lammers. The Examiner again indicates no teaching or suggestion in the prior art that would support the combination made.

The Examiner's own admissions and arguments as to improper combinations of references also support withdrawal of the Examiner's rejection under section 103(a). In his arguments, the Examiner admits that his obviousness rejection includes "necessarily a reconstruction based upon hindsight reasoning" (p. 6, line 3). Such use of hindsight is entirely improper in the context of an obviousness rejection. As the Federal Circuit Court of Appeals clearly and unequivocally indicated in In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998):

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

In re Rouffet at 1357.

In re Rouffet involved the reversal of both an Examiner and the Board of Patent Appeals for improperly combining a variety of features from various references in order to reject claims as obvious. Neither the Examiner nor the Board cited a motivation from the art itself for making the specific combinations, instead using merely a "rote invocation" of the presence of a high level of skill in the field to supply a motivation to combine the references.



Similarly, in In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999), an Examiner and the Board of Patent Appeals attempted to argue that claims drawn to a pumpkin face on a garbage bag were obvious in light of well known garbage bags and various references teaching creation of pumpkin-like objects using stuffed bags. The Federal Circuit Court of Appeals warned against the use of hindsight even in the area of less technologically complex inventions such as this, where the temptation is great:

Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.' . . .

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. . . .

In re Dembiczak at 999 (citations omitted).

In the final Office Action of August 17, 1999, the Examiner admits he made such an improper hindsight combination. He states the advantages of the present invention, as he sees them, and then pieces together the prior art to create an obviousness rejection. The Examiner shows no motivation from the reference or otherwise why an artisan in this field would combine the references of Ten Stix 21 with any of the references of Forte et al., Baerlocher et al., or Place et al. to solve the problem of improper play by players of the card game and auxiliary game disclosed.

Further, and more specifically, the Federal Circuit in In re Rouffet also held:

As this court has stated “virtually all [inventions] are combinations of old elements.” . . . Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.”

In re Rouffet at 1357 (citations omitted).

The Examiner’s final Office Action of August 17, 1999, reads exactly like such a blueprint based on the present invention. The Examiner lists each claimed feature as allegedly found scattered among various references, and then combines them as obvious. No motivation from within the art for making the specific combination of each element is provided. The Examiner does not show how a skilled artisan presented with the specific problems encountered, without knowledge of the present invention, would select the specific features included in the present invention.

The Examiner’s vague suggestion that the motivation for these specific combinations is to increase player participation and excitement is also unsupported by the references. All games are generally intended to some extent to increase participation and excitement of players. To allow this feature of games in general to therefore allow any combination of any features of any game with another would essentially render all future games unpatentable. Further, even if this improper basis for motivation were accepted, the Examiner has failed to

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show how the use of the present invention to prevent improper play by players provides a motivation for player participation and excitement.

The Examiner's reliance on In re McLaughlin, 443 F.2d 1392 (C.C.P.A. 1971), a case involving the patentability of the placement and design of railroad boxcar doors is misplaced for several reasons.

First and foremost, the court in In re McLaughlin was not even addressing the issue of the necessary motivation for combining references. Essentially, the language of that decision referenced by the Examiner stands merely for the proposition that it is possible to combine references to render a claim obvious and that in order to create the combination, the references must be combined in the form that replicates the invention. Nowhere does the decision sanction or even suggest as appropriate the use of hindsight in making the obviousness rejection. Quite the contrary, the court reiterates that "A patentable invention within the ambit of 35 U.S.C. §103, may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use." In re McLaughlin at 1395-1396, citing In re Spinnoble, 405 F.2d 58 (C.C.P.A. 1969).

Second, each of the prior art references in In re McLaughlin at least dealt with solving the same problem: how to most efficiently and fully fill a boxcar using various door and opening configurations. In contrast, the present invention solves the problem of how to prevent improper play of a card game in conjunction with an auxiliary game involving optional use of a card in either the card game or the auxiliary game. The references cited by

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the Examiner have nothing to do with solving this problem. To the extent that the Examiner believes these references are relevant because the invention solves the problem of increasing “player excitement and enjoyment,” it is respectfully submitted that this argument is too broad and misplaced.

Third, the court in In re McLaughlin ultimately reversed the Patent Office Board of Appeals with regard to one of the claims, finding that the Board had failed to show that the claim was obvious. The Examiner’s reliance on a decision finding in favor of the patentee demonstrates the questionable applicability of the decision to the Examiner’s argument.

Fourth, given the inapplicability of In re McLaughlin to the issue of motivation to combine references and the very recent, explicit decisions of the Federal Circuit Court of Appeals that the use of hindsight is entirely improper and must be guarded against in determining obviousness by the requirement of a clear showing from within the art of a motivation to combine the references with regard to each specific feature found obvious, this 1971 decision on the patentability of boxcar door configurations should not be relied upon to support the Examiner’s obviousness rejection.

For all of the above reasons, it is respectfully submitted that the claims now pending patentably distinguish the present invention from the prior art of record. Accordingly, reconsideration and withdrawal of the outstanding prior art rejections and an issuance of a Notice of Allowance are earnestly solicited.

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Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the attorney of record for this matter at the number listed below.

Respectfully submitted,

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